



PATENT APPLICATION
Attorney's Do. No. 8514-58

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of: Ned HOFFMAN

Serial No. 09/639,948

Examiner: Firmin BACKER

Filed: August 17, 2000

Group Art Unit: 3621

For: SYSTEM AND METHOD FOR TOKENLESS BIOMETRIC
AUTHORIZATION OF ELECTRONIC COMMUNICATIONS

TRANSMITTAL LETTER

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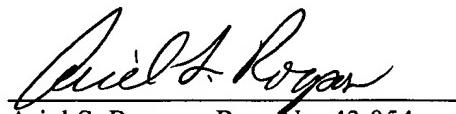
Enclosed for filing in the above-referenced application are the following:

- Reply Brief, in triplicate
- Any deficiency or overpayment should be charged or credited to deposit account number 13-1703.

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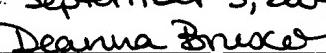
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Reply Brief
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REPLY BRIEF

UNDER 37 C.F.R. § 1.193(b)

In the Examiner's Answer to the Appeal Brief filed April 19, 2004, the Examiner has presented three arguments in support of his earlier final rejection of the claims. These arguments are, in turn: that the Office Action dated November 10, 2003, was properly final; that the Appellant has failed to point out the difference between the claimed invention and the prior art; and that the teaching of Drexler can be modified to include the concept taught by Rechtin, rendering the claimed invention obvious. These arguments are addressed in turn.

A. In section (11)A. on page 6 of the Examiner's Answer, the Examiner has argued that the Office Action of November 10, 2003, was properly made final. While the Examiner presented new grounds for rejection, the Examiner relies on MPEP § 706.07(a) to support his position that the Appellant's amendment to the claims filed on August 11, 2003 necessitated the new grounds for rejection. But the referenced amendment to the claims did not necessitate new grounds of rejection based on the Examiner's then-current grounds of rejection.

In the non-final Office Action dated April 9, 2003, the Examiner rejected claims 1-63 based on an argument that the claims were anticipated by Drexler et. al under 35 U.S.C. § 102(e). As the Examiner admitted in the subsequent Office Action, Drexler requires the use of smartcards or magnetic stripe cards.

The claims of Appellant's application, as originally filed, recited that biometric authorization occurs "without the user having to present *any personalized man-made memory tokens such as smartcards*, or magnetic stripe cards." The claims were amended on August 11, 2003, amending this clause in claims 1, 4, 5, 7, 32, 36, 37, and 39 to recite that biometric authorization occurs "without the user having to present *smartcards* or magnetic stripe cards." In other words, the amendment of August 11, 2003 removed the words "any personalized man-made memory tokens such as". Drexler could not anticipate these claims either in their original form or in their amended form because, as admitted by the Examiner, Drexler requires the use of personalized man-made memory tokens, namely smartcards or magnetic stripe cards. Drexler discloses the storing of a user's biometric information on a card, thereby personalizing that man-made memory token. If the rejection of the claims under 35 U.S.C. § 102(e), as asserted by the Examiner in the Office Action of April 9, 2003, were appropriate, this amendment would not overcome the rejection under 35 U.S.C. § 102(e), as it did not introduce a limitation not previously in the claims.

Thus, this specific amendment did not necessitate new grounds for rejection. As stated in MPEP 706.07, "[w]hile the rules no longer give to an applicant the right to 'amend as often as the examiner presents new references or reasons for rejection,' present practice does not sanction hasty or ill-considered final rejections." Because the finality of the Office Action of November 9, 2003 was ill-considered, the Appellant believes the Board of Appeals should reverse the finality of the claim rejections.

B. In section (11)B. on pages 6-7 of the Examiner's Answer, the Examiner has argued that the Appellant has failed to point out the difference between the claimed invention and the prior art. The Appellant respectfully directs the Board's attention to section VIII, subsection D of Appellant's Appeal Brief for specific discussions regarding the substantial differences between the claimed invention and the prior art.

C. In section (11)C. on pages 7-8 of the Examiner's Answer, the Examiner has argued that the teaching of Drexler can be modified to include the concept taught by Rechtin, rendering the claimed invention obvious. The Examiner asserts that Drexler "teaches all the steps in the claimed invention except the step of a transaction without using a card." Because Rechtin describes the concept that "[y]our thumbprint opens the [car] door," the Examiner asserts that Rechtin teaches a system that operates without a smartcard. According to the Examiner, this concept, in combination with Drexler, is enough to render the claims obvious.

First of all, the Examiner does not direct his argument to any of the claims specifically. In section (11)C. on pages 7-8 of the Examiner's Answer, the Examiner only directs his arguments toward section VIII, subsection D, part 1 subsection D of Appellant's Appeal Brief, which discusses appellant's claim Group 1; the Examiner makes no mention in the Examiner's Answer of any other claim groups. Because the Examiner has never made a specific rejection of any of the dependent claims, and because this argument is not specific to any of the claims, the Appellant is forced to conclude that this theory is directed to all of the claims generally.

As in all previous correspondences from the Examiner, the Examiner once again does not present a *prima facie* argument that claims 2-31 and 33-67 are obvious from Drexler in view of Rechtin. These dependent claims add further limitations that distinguish them over independent claims 1 and 32.

Even focusing the Examiner's argument in section (11)C. on pages 7-8 of the Examiner's answer on independent claims 1 and 32, Drexler and Rechtin cannot be combined as asserted. Under MPEP § 2143, to make a *prima facie* case for rejecting claims under 35 U.S.C. § 103(a) as obvious, the Examiner must satisfy three criteria. First, there must be a suggestion or motivation to modify the reference or combine the references' teachings. Second, there must be a reasonable expectation that the modifications will be successful. Third, the prior art must teach or suggest all of the claim limitations.

The Examiner has failed to meet at least the second criterion for a *prima facie* case for obviousness. While Rechtin suggests the benefits of a cardless system, Rechtin does not provide an enabling description of any method or system employing the fingerprint comparison machines in the article. As Drexler depends heavily on the use of the card, modifying Drexler to be a cardless system would require a complete redesign of the Drexler system. But there is no reasonable expectation of success to redesign Drexler, as suggested by the Examiner because neither the sparse disclosure of Rechtin nor the card-based system of Drexler disclose the limitations necessary to implement a cardless system as claimed. Thus, the combination of Drexler and Rechtin cannot render claims 1 and 32 (let alone claims 2-31 and 33-67) obvious.

D. In section (11)E. on page 8 of the Examiner's Answer (note that section (11)D. is omitted from the Examiner's Answer), the Examiner simply argues that the parts 2-8 of section VIII, subsection D of the Appellant's Appeal Brief rely on the same arguments as part 1. The Examiner therefore provides no additional argument. The Appellant argues that

parts 2-8 or section VIII, subsection D of the Appellant's Appeal Brief provide distinct arguments, and provide independent reasons why the claims of groups 2-8 should be allowed.

Claim 2 is a representative member of Group 2 and is additionally directed toward storing registered biometric samples in a master electronic identicator, where that master electronic identicator includes a database of registration samples from many users. The Examiner has never presented any arguments directed toward this added limitation.

Claim 4 is a representative member of Group 3 and is additionally directed to using the electronic identicator to compare a user's bid biometric sample to a registration biometric sample to *both* identify the user and authorize an electronic communication without having to present smartcards or magnetic swipe cards. The Examiner has never presented any arguments directed toward this added limitation.

Claim 5 is a representative member of Group 4 and additionally directed toward a third-party enterprise submitting registration identity data and that registration identity data being used to identify a third-party enterprise in conjunction with a user being biometrically *identified* and an electronic communication biometrically authorized without the user having to present smartcards or magnetic swipe cards. The Examiner has never presented any arguments directed toward this added limitation.

Claim 17 is a representative member of Group 5 and is additionally directed toward utilization of rule module formation and invocation steps where the rule-module includes at least one user-customized pattern data associated with at least one execution command.

Claim 18 is also a representative member of Group 5 and further recites that the data pattern could be any of a number of data including a unique user identification code, demographic information, digital signature or data on user behavior patterns (as well as many other recited possibilities). The Examiner has never presented any argument directed toward these additional limitations.

Claim 26 is a representative member of Group 6 and is additionally directed toward using a master rule-module clearinghouse for storing the rule-modules of many users. The Examiner has never presented any argument directed toward this additional limitation.

Claims 10 and 12 are representative members of Group 7 and are additionally directed toward a user providing a personal identification code and that personal identification code being changed when the user's registered biometric sample is determined to have been fraudulently duplicated. The Examiner has never presented any argument directed toward this additional limitation.

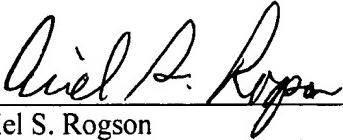
Claims 11 and 43 make up Group 8 and are additionally directed to alerting the electronic identifier of claim 1 when a user has attempted to re-register a biometric sample. The Examiner has never presented any argument directed toward this additional limitation.

Finally, any additional arguments from Appellant's Appeal Brief that have not been specifically discussed above are incorporated by reference herein for re-presentation.

In summary, Appellant's amendment filed August 11, 2003 did not necessitate new grounds for rejection by the Examiner and, thus, the Examiner was unwarranted in making the subsequent Office Action final. Further, Drexler and Rechtin cannot be combined to make the claimed invention obvious and, even if they were combined, would not enable a person of ordinary skill in the art to implement a cardless biometric system as claimed. Thus, Appellant's claims 1 and 32 are patentable under 35 U.S.C. § 103(a) over Drexler in view of Rechtin. Finally, the Examiner has failed to presented distinct *prima facie* arguments directed toward the added limitations of dependent claims 2-31 and 33-67 in Appellant's application. Thus, Appellant's claims 2-31 and 33-67 are patentable under 35 U.S.C. § 103(a) over Drexler in view of Rechtin.

For the foregoing reasons, Appellant requests that the Board reverse the Examiner's rejections to Appellant's claims.

Respectfully submitted,
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ON: September 3, 2004
Dorraine Brusco